

**REMARKS AND ARGUMENTS**

**Election/Restrictions**

Examiner has acknowledged receipt of the Group 1 election as filed in the reply of February 8, 2006. Examiner indicates that because Applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse. Therefore, it is understood that claims 1-16 and 34 are the subject of prosecution in this office action.

**Notes & Remarks**

The Examiner has noted that the numbering of the claims is not in accordance with 37 C.F.R. 1.126, which requires the original numbering of the claims to be preserved throughout the prosecution. All claims have been renumbered and/or amended if necessary in accordance with Examiner's suggestion.

**Claim Rejections**

**35 U.S.C. 102(b)**

**Claims 1-3**

Examiner rejected Claims 1-3 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,779,434 to Reinert ("Reinert"). The Examiner's arguments and the references were carefully studied.

Reinert generally discloses an airport inset light adjustable alignment container set for rotatably adjusting the height and azimuth of an airport runway light. The apparatus consists of an adjustable extension 55 that is tubular and cylindrical in nature (col. 10, lines 17-18). The extension, which is the wall of cylinder portion, contains a non-threaded

top portion 58 and a bottom portion 57 that is threaded with Acme threads (col. 10, lines 17-20). A circular adapter flange 85 is provided with a threaded surface to accept the threads of the extension portion (See FIG. 6). The adapter flange also contains at least one non-threaded aperture 86 for accepting an Allen set-screw component 81 so that the extension can be secured to the adapter flange (See FIGS. 4-6).

The result of this arrangement is that the inset airport light can be rotatably adjusted in both height and azimuth in order to account for resurfacing and other changes in an airport runway surface. Once the desire height and azimuth are achieved, the unit can then be secured in place via the aforementioned screw components (See FIGS. 4-6). However, a limitation of this arrangement is that only the height and azimuth are capable of being adjusted due to the thread arrangement. Therefore, the angular nature of the mechanism cannot be adjusted.

The present invention is distinguishable from Reinert. The adjustment mechanism of the in-grade light fixture of claim 1 is capable of not only adjusting the height of the faceplate mechanism, but also the angle. This is accomplished using a series of adjustment posts arranged around a housing opening such that the height of each post is capable of being individually raised or lowered to raise and lower the corresponding portion of the faceplate (See FIG. 2). The result of this arrangement is that both the height and angle of the faceplate can be adjusted to account for variations in the surface where the light is inset or for aesthetic preferences. This arrangement prevents the limitations associated with a threaded adjustment mechanism since the posts allow for height and angle adjustment.

Claim 1 is an independent claim from which claims 2-3 depend. Applicant respectfully submits that claim 1 is allowable over Reinert. Reinert does not disclose, teach or suggest an arrangement whereby the level **and angle** of a faceplate can be adjusted using a plurality of adjustment posts. As written, claim 1 reflects this novel arrangement by clarifying that the adjustment mechanism "allow[s] the height **and angle** of said faceplate mechanism to be adjusted over said light opening to match the height **and angle** of the surrounding grade level and angle" (emphasis added). Applicant submits that claim 1 as written is allowable, and claims 2-3 are allowable as depending from allowable claim 1. Applicant respectfully requests reconsideration of the examiner's rejection herein.

Claims 9-12 and 14-16

Examiner rejected Claims 9-12 and 14-16 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 3,463,913 to Shavalier ("Shavalier"). The Examiner's arguments and the references were carefully studied.

Shavalier generally discloses an airport runway marker lighting unit for rotatably adjusting the faceplate mechanism. The apparatus consists of a cylindrical metal hub 20 with an open upper end that is capable of being embedded in an airport runway (See FIG. 5). On said upper end is a ring 33, a housing flange 25 and a top closure 50, all of which contain holes to accept screws (FIG. 5). The ring 33 also contains arcuate slots 34-39 for accepting screws which are the same in number and spaced according to the holes in the flange 25 (col. 2, lines 61-63).

The result of this arrangement is that the ring member 33 can be rotatably adjusted to effect proper orientation with the

top closure 50 (col. 4, lines 26-29). Once the proper orientation is achieved, the ring, flange and top closure can then be secured in place via the screw components (See FIG. 5). However, a limitation of this arrangement is that the faceplate mechanism can only be rotatably adjusted. Therefore, the angular and vertical nature of the mechanism cannot be adjusted.

The present invention is distinguishable from Shavalier. The faceplate mechanism of the in-grade light fixture of claim 9 is capable of not only rotatably adjusting the faceplate, but also the height and angle. This arrangement prevents the limitations associated with the Shavalier invention since the faceplate mechanism is only capable of rotatable adjustment.

Claim 9 is an independent claim from which claims 10-12 and 14-16 depend. In order to better reflect the novel arrangement of claim 9, it has been amended to clarify that the faceplate mechanism is "adjustable over said light opening to match the height and angle of the surrounding grade level and angle." Accordingly, claim 9 as amended is allowable. Claims 10-12 and 14-16 depend from claim 9 and as such are also allowable.

35 U.S.C. 103(a)

Claim 4

Examiner rejected Claim 4 under 35 U.S.C. 103(a) as being unpatentable over Reinert in view of U.S. Patent No. 4,996,635 to Olsson et al ("Olsson"). The Examiner's arguments and the references were carefully studied. However, claim 4 depends from independent and allowable claim 1. Applicant thus respectfully requests the withdrawal of Examiner's rejection under 35 U.S.C. 103(a) with respect to claim 4.

Claims 1 and 5-8

Examiner rejected Claims 1 and 5-8 under 35 U.S.C. 103(a) as being unpatentable over Reinert in view of Shavalier. The Examiner's arguments and the references were carefully studied.

To establish *prima facie* obviousness of a claimed invention, **all the claim limitations must be taught or suggested by the prior art.** *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under **35 U.S.C. 103**, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). MPEP 2143.03.

Claim 1 is an independent claim from which claims 5-8 depend. Applicants respectfully submit that there is no motivation or suggestion to modify the reference in the manner suggested by the Examiner for at least the following reason: neither of the prior art references suggest the desirability of the claimed invention.

As stated above, the Examiner incorrectly states that Shavalier discloses an airport runway lighting system with a faceplate that can be *angularly* adjusted. Neither Reinert nor Shavalier disclose, teach or suggest an arrangement whereby the height and angle of a faceplate can be adjusted using a plurality of adjustment posts. Rather, Shavalier discloses a faceplate that can only be *rotatably* adjusted. Accordingly, all the claim limitations must be taught or suggested by the prior art and the examiner failed to establish obviousness.

For the reasoning stated above, Applicants respectfully submit that claim 1 is allowable and request withdrawal of the

rejection of claim 1 under 35 U.S.C. 103(a). Claims 5-8 depend from claim 1 and are also allowable.

Claim 13

Examiner rejected Claim 13 under 35 U.S.C. 103(a) as being unpatentable over Shavalier in view of Olsson. The Examiner's arguments and the references were carefully studied. However, claim 13 depends from independent and allowable claim 9. Applicant thus respectfully requests the withdrawal of Examiner's rejection under 35 U.S.C. 103(a) with respect to claim 13.

Claim 34

Examiner rejected Claim 34 under 35 U.S.C. 103(a) as being unpatentable over Reinert in view of Shavalier and U.S. Patent No. 6,254,258 to Case ("Case"). The Examiner's arguments and the references were carefully studied.

As mentioned above, to establish *prima facie* obviousness of a claimed invention, **all the claim limitations must be taught or suggested by the prior art.** In *re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Reinert, Shavalier, and Case do not disclose, teach or suggest an arrangement whereby a lighting system apparatus can be rotatably adjusted at its faceplate; can be vertically and angularly adjusted via a plurality of adjustment posts. Specifically, these references do not disclose at least the following claim element:

"an adjustment mechanism to allow the height and angle of said faceplate mechanism to be adjusted over said light opening to match the height and angle of the surrounding grade level and angle" (emphasis added)

Appl. No. 10/799,393  
Amdt. Dated August 7, 2006  
Reply to Office action of April 6, 2006


For the reasoning stated above, Applicant respectfully submits that claim 34 is allowable and requests withdrawal of the rejection of claim 34 under 35 U.S.C. 103(a).

**CONCLUSION**

Applicants respectfully submit that all of the claims herein are allowable and request that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

August 7, 2006

  
\_\_\_\_\_  
Jaye G. Heybl  
Attorney for Applicants  
Registration No. 42,661

KOPPEL, PATRICK & HEYBL  
555 St. Charles Drive, Suite #107  
Thousand Oaks, CA 91360  
(805) 373-0060